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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,904	06/14/2006	Gianni Minganti	MINGANTI	9222
1444 7590 05/04/2011 Browdy and Neimark, PLLC 1625 K Street, N.W. Suite 1100 Washington, DC 20006			EXAMINER SCHATZ, CHRISTOPHER T	
			ART UNIT 1747	PAPER NUMBER
			MAIL DATE 05/04/2011	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/537,904

Applicant(s)

MINGANTI, GIANNI

Examiner

CHRISTOPHER SCHATZ

Art Unit

1747

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-9 and 11-19 is/are pending in the application.
- 4a) Of the above claim(s) 1,2 and 5-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-945)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Newly amended claims 1, 2 and 5-9 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The claims are directed to an embodiment of the invention that is a mutually exclusive Species from the embodiment previously claimed and examined. Claim 1 now requires a "longitudinally extending stationary device for directly supporting from above at least two containers held together by means that attach to a collar on each said container". This is directed to the embodiment of figures 1-8 (herein referred to as Species A), which is directed to the embodiment of using steel wires to support more than one container and using a heating tunnel 60 to heat and shrink the label on the container. In said embodiment, the heater is not supported by the vertically movable support plate that is capable of mounting the label on a container. In the embodiment of figures 9-13 (herein referred to as Species B), the support means for supporting a container from above are grippers, and the heater is supported by the vertically movable support plate.

2. The Species are independent and distinct because they are mutually exclusive.

Additionally, there is a search and/or examination burden for the patentably distinct species as set forth above because at least the following reason(s) apply:

(a) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);

(b) the prior art applicable to one invention would not likely be applicable to another invention.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 1, 2 and 5-9 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 11-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.
5. Claim 11 requires that the vertical support plate support both the heater and a mounting device capable of mounting an annular band from below. The specification as

originally filed does not support such an apparatus. While the specification provides support for the support plate supporting a heater, it does not provide support for a support plate that supports a mounting device capable of mounting a band onto a container from below.

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
7. Claims 11-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Amberg (US 3767496) in view of Marchesini (US 4991377).

As to claims 11 and 15, Amberg discloses an apparatus capable of labeling at least one container having a rim or collar, said apparatus comprising: a support positioned above said at least one container and configured to support and transport said at least one container in a suspended erect position; a mounting device configured to mount a vertically disposed heat-shrinkable annular band onto said at least one container from below (means 71-73; figure 9, discussion of figure 9); a heater for adhering said heat-shrinkable annular band to said at least one container by heat-shrinkage; and at least one vertically movable support plate 70 that supports the mounting device (figures 10, 11, 14-16, discussion of said figures; column 6, line 54 – column 7, line 60).

It is not clear if Amberg discloses an apparatus wherein the support plate supports a heater capable adhering a heat shrinkable band to a container.

Marchesini discloses a device capable of adhering an annular heat shrinkable label to a cylindrical container, wherein said means 20 (figure 3) capable of causing an annular label to adhere to a cylindrical container by heat-shrinkage is in the shape of a cylinder, wherein said band and container can be placed within an opening in said cylinder to receive heat from an ejected fluid (figure 3; column 5, lines 11-25). The cylinder comprises a plurality of nozzles 6a. At the time the invention was made it would have been obvious to one of ordinary skill in the art to modify the apparatus of Amberg such that said adhering means comprises a plurality of fluid dispensing nozzles as taught by Marchesini as such a modification would enable the apparatus to uniformly heat a label around its entire circumference thus enabling said apparatus to produce a better connection between a label and a bottle in a more efficient manner (column 5, lines 11-30). Furthermore, Marchesini discloses that the label and bottle are raised from below such that said label and bottle are moved within said cylinder (figure 3). One of ordinary skill in the art would thus have readily recognized to place the cylinder on the supporting plate as such a modification would enable the apparatus to immediately heat shrink the annual band onto a container and reduce the size of the apparatus, thus increasing efficacy and reducing costs. At the time the invention was made it would have been obvious to one of ordinary skill in the art to further modify Amberg as modified by Marchesini such that the means for causing an annular band to adhere to a contain by heat shrinkage is supported by the vertically movable support plate as doing such would achieve the benefits discussed above.

As to claim 12, the vertically movable support plate 70 of Amberg is configured to vertically transport said heat-shrinkable annular band onto said at least one container. As to claim 13, the modified means for heat shrinking comprises a heater capable of delivering hot fluid (column 3, lines 31-34). As to claim 14, Marchesini discloses steam (column 3, lines 31-33). As to claim 16, Amberg discloses the vertically movable support plate comprises a unit 66 (figure 11) capable of keeping an annual band vertical.

8. Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Amberg and Marchesini, as applied to claims 11 and 16 above, and further in view of Konstantin (US 4514966) and Lerner et al. (US 5483783).

It is not clear if Amberg and Marchesini disclose a device wherein the unit for maintaining a band vertical comprises four vertical rods branching from a second plate connected to the vertically moveable support plate via at least one cylinder piston unit. Konstantin discloses a plant and device for labeling a container, said plant capable of placing a preformed band around a bottle (figure 1), comprising a unit for maintaining a band vertical, wherein said unit comprises four vertical rods 1, 1' 2, 2'. At the time the invention was made it would have been obvious to one of ordinary skill in the art to modify the apparatus of Amberg as modified by Marchesini such that the unit for maintaining a band vertical comprises four vertical rods as taught by Konstantin above as doing such enables the apparatus to place bands around bottles of different circumferences. Lerner discloses a plant for placing a band on a bottle comprising a movable plate (turret) and further discloses and unit for maintaining a band vertical

wherein said unit comprises rods branching from a fixed second plate 152 (figures 12-14, 16 and discussion of said figures) said fixed second plate connected to said fixed plate via a cylinder piston (column 8, lines 42-61). At the time the invention was made it would have been obvious to one of ordinary skill in the art to further modify Amberg as modified by Marchesini and Konstantin such that the rods are connected to a second plate as taught by Lerner above as doing such enables the apparatus to supply air between a band and bottle via said rods thus reducing friction during the placing of said band on said bottle (column 8, lines 42-61).

As to claim 18, Konstantin discloses rods on a perimeter of an imaginary circumference (figures). The rods are capable of maintaining a band widened. Additionally, one of ordinary skill in the art would have readily understood to equally space the rods around the perimeter of the circumference as doing such would provide support to the band at equally spaced locations along the circumference. As to claim 19, Lerner discloses holes 144 (figure 12) in the movable plate.

Response to Arguments

9. Applicant's arguments filed 10/20/2010 have been fully considered. Applicant's arguments with respect to claims 1, 2 and 5-9 are moot in view of the withdrawal of said claims as discussed above.

The applicant argues that page 3, lines 4-8 of the specification provides support for the limitation requiring "at least one vertically movable support plate that is attached to and supports both the mounting device and the heater". The disclosure on page 3,

lines 4-8, does not provide support for such a limitation. Said disclosure never discloses a vertically moveable support plate. Additionally, contrary to the applicant's assertion, the disclosure never states that the "device" supports the means for mounting and means for causing the label to adhere to the container. The disclosure states that the "device" is for "supporting and transporting at least one container". There no further disclosure of any structural relationship between the "device" and the means for mounting and means for causing the label to adhere to the container. Finally, the applicant appears to be equating the "device for supporting and transporting at least one container" to the vertically moveable plate claimed in claim 11. This is in direct contradiction to the applicant's own specification since the "device for supporting and transporting at least one container" is either steel wires (Species A) or grippers (Species B). No part of the specification discloses a "vertically movable plate" as the "device for supporting and transporting at least one container" and one of ordinary skill in the art would certainly not understand the "device for supporting and transporting at least one container" recited on page 3, lines 4-8 as the "vertically movable plate" in light of the other portions of the applicant's specification.

The applicant further cites pages 7-8 of the specification as providing support. The applicant states that the disclosure states that the vertically movable support plate carries the label support means and the heater. The examiner agrees. However, contrary to the applicant assertion, the label support means is not the mounting device. First, nowhere in the original specification does the applicant state that the label support means is the mounting device. Second, original claim 1 recites that "said means for

mounting a heat-shrinkable annular band onto said container comprise at least one movable support plate". Thus, one of ordinary skill in the art in possession of the original specification would understand that the mounting means comprises the vertically movable support plate, rather than the mounting means being supported by the vertically movable support plate. The applicant does not have support to claim that the vertically movable support plate support the mounting device because the vertically movable support plate is part of the mounting device. Even assuming for the sake of argument that the label support means is part of the mounting device, the label support means alone is not sufficient to perform the function of the label mounting device required by claim 11 - that of being able to mount the annual band on the container from below. Thus the required function of the mounting device recited in claim 11 at a minimum requires that the mounting device comprise at least the vertically movable plate.

As to applicant's arguments on the bottom of page 12 of the Remarks, fourth full paragraph of the Remarks as they might apply to claim 11, said arguments amount to an individual attack on Marchesini without considering Marchesini in combination with Amberg. Applicant is reminded that one cannot show nonobviousness by attacking references individually and in a vacuum of each other as a rejection under 35 U.S.C. 103 is a consideration relating to the combined teachings of the references (and not each reference in a vacuum of the others).

The applicant states that the heater 20 of Marchesini would have to be substituted for the oven chamber 77 of Amberg, which does not seem possible. The

applicant should note that in the modified apparatus, the heater 20 of Marchesini would be attached on the support plate as discussed above, rather than substituted for the oven 77 downstream. The applicant asserts that the heater of Amber is stationary. This is not germane to the merits of the rejection because whether or not the heater of Amber is stationary has no bearing on whether or not it would have been obvious to modify Amber as taught by Marchesini as discussed above. The applicant states that the annular member could not warm the entire length of the sleeve in the modified apparatus. This is an argument directed toward the material to be worked upon. The applicant should note that "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim". MPEP 2115.

The applicant argues that there is no teaching or suggestion in Marchesini that the heater be movable. This argument is not commensurate with the scope of the claims since the claims do not require the heater to be movable. The applicant states that there is simply nothing in Amber or Marchesini that discloses or suggests that the heater be attached to the vertical support plate. The applicant is referred to the discussion at the bottom of page 5 above. The fluid source of Marchesini need not rotate in order for the modified apparatus of Amber to be capable of performing the required language of claim 11.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTOPHER SCHATZ whose telephone number is (571)272-6038. The examiner can normally be reached on IFP.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571)272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CHRISTOPHER SCHATZ/
Examiner, Art Unit 1747